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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/997,411	12/23/97	KENJI	Y 01309.73108

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EXAMINER

CARIASO, A

ART UNIT

2875

PAPER NUMBER

DATE MAILED: 04/15/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>08/997,411</b>	Applicant(s) <b>Kenji</b>
	Examiner <b>Alan Cariaso</b>	Group Art Unit <b>2875</b>

Responsive to communication(s) filed on \_\_\_\_\_.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-13 is/are pending in the application.

Of the above, claim(s) none is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-13 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2875

## **DETAILED ACTION**

### ***Drawings***

1. The drawings were received on Dec 23, 1997. These drawings are approved by the Draftsperson.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2, 3, and 7-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2, line 1, "the opening" has no antecedent basis.

Claim 3, line 2, and claim 7, line 2; "each arbitrary surface" is indefinite as to which part of the invention this is related or a part of.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2875

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3, 5, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Madansky.

Madansky discloses a lighting unit comprising a substantially ring-shaped transparent body (10) for light diffusion (col. 3, lines 59-69; col. 5, lines 6-7), a plurality of illuminants (25) being positioned along a light-introduction surface (24) in order to emit light from a light-emission surface (11) of the transparent body (10); the transparent body (10) having a center hole (10a); wherein a reflective layer (30) is provided on each arbitrary surface (12b,12c) reflecting light into the transparent body (10); wherein the light emission surface (11) of the transparent body is a concave face of a hollow truncated cone shape (col. 2, lines 40-47).

6. Claims 1, 3, 4, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith.

Smith discloses a lighting unit comprising a ring-shaped transparent body (11), a plurality of illuminants (17) being positioned along a light-introduction surface (11c) in order to emit light from a light-emission surface (11a) of the transparent body (11); the transparent body (11) having a center hole (12); wherein a reflective layer (13) is provided on each arbitrary surface (11b) reflecting light into the transparent body (11); wherein the light emission surface (11a) of the transparent body is a ring-shaped plane (11a, fig. 1). As for the phrase on claim 1, lines 1-2, "for light diffusion", a recitation of the intended use of the claimed invention must result in a structural

Art Unit: 2875

difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2, 6, 7, and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Madansky in view of Clapham, Jr.

Madansky discloses applicant's invention of a light diffusing transparent body device, except a transparent silicon filling between the illuminants and transparent body. Clapham Jr. teaches the use of a silicone elastomeric material (17; col. 3, line 70 thru col. 4, line 10) for the purpose of positioning at least one light source (10) adjacent a light-introduction surface (14) of a transparent body (13). It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to modify the lighting unit of Madansky to include the type of

Art Unit: 2875

transparent silicone material filler as taught by Clapham Jr in order to position at least one light source relative a light-introduction surface of a transparent body.

Madansky discloses applicant's invention of a light diffusing transparent body device with the light-emission surface (11) being a concave or hollow truncated cone shape, except the light-emission surface being a bowl shape. It would have been an obvious matter of design choice to modify the truncated cone shaped light-emission surface (11) of Madansky to include a bowl shape, since applicant has not disclosed that this particular concave shape light-emission surface (bowl shape) solves any stated problem or is for any other particular purpose and it appears that the invention would perform equally well with the concave cone shaped light-emission surface of the transparent body of Madansky.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Madansky in view of Clapham, Jr. as applied to claims 2, 6, 7, and 10-13 above, and further in view of Clem.

Madansky discloses applicant's invention of an edge-lit dial instrument panel device except a ring-shaped planar light-emission surface of the transparent body. Clem teaches the use of a edge-lit transparent body (50, fig. 4) having a ring-shaped planar light-emission surface (16) for the purpose of emitting light toward a dial instrument panel (18). It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to modify the lighting unit of Madansky to include the type of ring-shaped planar light-emission surface as taught by Clem in order to illuminate a dial instrument panel.

Art Unit: 2875

*Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Clem, Swadell, and Hitora show other various ring-shaped transparent bodies with plural illuminants emitting light through the diffusive transparent bodies. Schoniger et al show a circular transparent body with a ring-shaped planar surface. Koike et al show a light guide made of a silicone material. Dimmick shows a light guide with a hole filled with a light source and light-dispersion potting material.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Cariaso whose telephone number is (703) 308-1952.

AC

April 12, 1999



ALAN CARIASO  
PRIMARY EXAMINER